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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/439,807 11/12/99 MARCASE

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EXAMINER

VARMA, S

ART UNIT

PAPER NUMBER

3711

DATE MAILED:

08/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/439,807

Applicant(s)
Marcase

Examiner
Sneh Varma

Art Unit
3711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 30, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) None is/are withdrawn from consideration.
- 5) ☒ Claim(s) None is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) None is/are objected to.
- 8) ☒ Claims None are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

Art Unit: 3711

DETAILED ACTION

Response to Amendment

1. This office action is in response to applicant's amendment filed on May 30, 2001 in which remarks were submitted. In response to Applicant's remarks the Examiner has set forth a rejection below.

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 19, and 20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mertens '113 (Mertens).

Mertens discloses a golf club head 10, (Figures 1-7; Column 4, lines 31-54) comprising: a hosel 16, located at a heel 18, end to accommodate a shaft, and a metal blade comprising a striking face 22, , a sole, and a rear face, the striking face and the sole meeting at a knife-like leading edge 28, the sole having a protrusion running substantially parallel to the leading edge and located at the juncture of the sole and the rear face, the rear face meeting the striking face at a trailing edge 30; a shaft attached to the hosel 16, and having a handle positioned at an end opposite the hosel; and the striking face is abrasive (Column 9, lines 20-60).

Art Unit: 3711

4. Claims 1 and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Koehler '944 (Koehler).

Koehler discloses a golf club head 10, (Figures 3a-3c; Column 3, lines 62-68; Column 4, lines 1-12) comprising: a hosel 14, located at a heel 32, end to accommodate a shaft, and a metal blade comprising a striking face 16, a sole 20, and a rear face, the striking face and the sole meeting at a knife-like leading edge 22, the sole having a protrusion running substantially parallel to the leading edge and located at the juncture of the sole and the rear face, the rear face meeting the striking face at a trailing edge 24; a shaft attached to the hosel 14, and having a handle positioned at an end opposite the hosel.

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title; if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mertens in view of Sun et al. '041 (Sun) and Simmons '097 (Simmons).

Mertens discloses the invention as recited above, however, fails to disclose metal dowels. Sun teaches the use of metal dowels 16, (Column 2, lines 45-52). The diameter of these dowels 16, is between 0.375 inch and 0.4375 inch (Column 2, lines 53-62); and the metal dowel is made of a metal having a density greater than the density of the metal from which the metal blade is

Art Unit: 3711

formed (Column 2, lines 45-62); the metal dowel is made of lead and the club head is made of steel. Simmons teaches the use of a golf club head with metal dowel 30, (Column 3, lines 31-61) with diameter between 0.375 inch to 0.4375 inch and the use of tungsten, lead and other suitable metals.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the metal dowels as taught by Sun and Simmons in the Mertens device to improve the performance of the golf club head. For one of ordinary skill in the art, the choice of designing the club head such that a leading metal dowel and a trailing metal dowel disposed in the metal blade and located substantially on each side of an apex of the protrusion of the sole, the leading metal dowel disposed between the protrusion of the sole and the leading edge and the trailing metal dowel disposed between the protrusion of the sole and the trailing edge, would depend on the cost of manufacturing and the design requirements.

The modified Mertens device is a means to achieve the same function of propelling the ball onto the fairway or green from the rough as that claimed for the invention. Since the Applicant has failed to provide any evidence of unexpected results using the structure claimed in Claims 11-12 and 16-18 of the claimed invention which could contradict the recitation above, clearly the Applicant's claimed dimensions are obvious and lack criticality. The Applicant has not presented new and unexpected results to substantiate that the dimensions claimed are critical. An artisan skilled in the art would use suitable angles and thicknesses for the leading and trailing edges depending on the design requirements at the cost of manufacturing.

Art Unit: 3711

7. Claims 2-13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koehler in view of Sun and Simmons.

Koehler discloses the invention as recited above, however, fails to disclose metal dowels. Sun teaches the use of metal dowels 16, (Column 2, lines 34-62). The diameter of these dowels 16, is between 0.375 inch and 0.4375 inch (Column 2, lines 53-62); and the metal dowel is made of a metal having a density greater than the density of the metal from which the metal blade is formed (Column 2, lines 45-62); the metal dowel is made of lead and the club head is made of steel. Simmons teaches the use of a golf club head with metal dowel 30, (Column 3, lines 31-61) with diameter between 0.375 inch to 0.4375 inch and the use of tungsten, lead and other suitable metals.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the metal dowels as taught by Sun and Simmons in the Koehler device to improve the performance of the golf club head. For one of ordinary skill in the art the choice of designing the club head such that leading metal dowel and a trailing metal dowel disposed in the metal blade and located substantially on each side of an apex of the protrusion of the sole, the leading metal dowel disposed between the protrusion of the sole and the leading edge and the trailing metal dowel disposed between the protrusion of the sole and the trailing edge, would depend on the cost of manufacturing and the design requirements.

Art Unit: 3711

8. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Mertens or Koehler, as applied to claim 1 above, and further in view of Gordos '133 (Gordos) and Antonio us '668 (Antonio us).

Mertens and Koehler disclose the invention as recited above, however, fail to disclose that the knife-like leading edge is serrated. Gordos teaches the use of a golf club head with serrated 34a, sole 14, (Column 2, lines 12-65). Antonio us teaches the use of a golf club with serrated sole 204, (Figures 13 and 13a; Column 6, lines 53-65) with the distance between a pair of adjacent troughs of the knife-like leading edge between 0.1875 inch and 0.250 inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the serrated sole as taught by Gordos and Antonious in either the Martens or Koehler device to improve the golf club head sole configuration as suggested by Antonious (Column 1, lines 1-45).

Response to Arguments

9. Applicant's arguments filed on May 30, 2001 have been fully considered but they are not persuasive. The Applicant has argued that the claimed limitation "knife-like leading edge of the invention is patentably distinct. Applicant has further argued that the purpose of the leading edge is to cut through grass whereas neither Mertens nor Koehler devices have this structure. This argument is not germane since the Applicant has not claimed these characteristics. The Examiner has rejected the claims as they claim a limitation. The limitations of the Claims 1, 19, and 20 are clearly anticipated by the Mertens patent, and the limitations of Claims 1 and 19 are clearly

Art Unit: 3711

anticipated by Koehler. The Claim language has not been amended by the Applicant to distinctly claim the invention.

In response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Mertens is motivated to move the ball from the rough (Column 1, lines 24-25). The Applicant's argument that the Koehler's device does not cut the grass but spreads it does not make the claimed invention patentably distinct. Koehler's leading edge is designed with the same motivation as the invention. An artisan skilled in the art would choose to design the leading edge sharp enough to cut the grass based on the design requirements and the cost of manufacturing. The modified Mertens and Koehler devices are the means to achieve the same function as that claimed for the invention. Since the Applicant has failed to provide any evidence of unexpected results using the claimed invention which could contradict the recitation above, clearly the Applicant's claimed limitations are obvious and lack criticality. The Applicant has not presented new and unexpected results to substantiate that the limitations claimed are critical.

Art Unit: 3711

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Varma whose telephone number is (703) 308-8335. The examiner can normally be reached on Monday to Friday from 8:00 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Jeanette Chapman, can be reached on (703) 308-1310.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7768. Any inquiry of a general nature or relating to the status of this

Application/Control Number: 09/439,807

Page 9

Art Unit: 3711

application or proceeding should be directed to the receptionist whose telephone number is (703)
308-1078.

August 1, 2001

Sneh Varma, Patent Examiner

Art Unit 3711


JEANETTE CHAPMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER STC

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.